

REMARKS

I. Introduction

Claims 14 to 32 are pending in the present application. In view of the following remarks, it is respectfully submitted that claims 14 to 32 are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for indicating the acknowledgment for the claim to foreign priority under 35 U.S.C. 119 and that all copies of the certified copies of the priority documents have been received in the National Stage application from the International Bureau.

II. Rejection of Claims 14, 16, 18, 20, 22, 23, 25, 26 and 28 to 32 Under 35 U.S.C. 103(a)

Claims 14, 16, 18, 20, 22, 23, 25, 26 and 28 to 32 were rejected under 35 U.S.C. § 103(a) as unpatentable over United States Patent 5,899,785 ("Groten et al.") in view of United States Patent 6,090,730 ("Fujiwara et al.") Applicants respectfully submit that the combination of Groten et al. and Fujiwara et al. do not render obvious claims 14, 16, 18, 20, 22, 23, 25, 26 and 28 to 32 for the following reasons.

Claim 14 relates to a nonwoven fabric for manufacturing repeatedly re-usable clean-room protective clothing, made of super microfilaments having a titer of less than 0.2 dtex that are in turn produced by water jet splitting multicomponent filaments (referred to as "primary filaments" in the following) having a titer of less than 2 dtex, the primary filaments being spun from a melt, aerodynamically stretched, directly laid to form a nonwoven fabric, and subjected to water-jet prebonding prior to splitting.

The Office Action admits that Groten et al. do not specify that filaments are drawn aerodynamically. The Office Action alleges that Fujiwara et al. teach filaments that are drawn using air suction.

Groten et al. do not disclose or suggest the feature of water-jet prebonding of fibers. The Office Action merely provides reference to columns 3 line 55 to column 4 line 12 for the alleged "pre-bonding". Information contained in column 3 line 55 to column 4, line 12 only refers to filaments which has a "crimp" that is accentuated through use of water. As a result, a "crimp" or bending of the

fiber is produced through the addition of the water process. The fibers, as such, are not probonded, merely bent.

The addition of Fujiwara et al. does not cure the defect of Groten et al. Fujiwara et al. do not disclose or suggest any water-jet prebonding of fibers. As a result, the combination of references do not disclose or even suggest the features of claim 14.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of references does not disclose, or even suggest, all of the limitations of claim 14. It is therefore respectfully submitted that the combination of references does not render obvious claim 14.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as

opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

In view of the foregoing, it is respectfully submitted that the combination of the references does not render obvious claim 14.

Claims 16, 18, 20, 22, 23, 25, 26 and 28 to 32 ultimately depend from claim 14 and therefore include the features of claim 14. Applicants respectfully submit that claims 16, 18, 20, 22, 23, 25, 26 and 28 to 32 are patentable for at least the reasons provided for claim 14.

III. Rejection of Claims 15, 17, 19, 21, and 27 Under 35 U.S.C. § 103(a)

Claims 15, 17, 19, 21 and 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over Groten et al. and Fujiwara et al. in view of United States Patent 5,730,923 ("Hassenboehler, Jr. et al."). Applicants respectfully submit that the combination of Groten et al., Fujiwara et al. and Hassenboehler, Jr. et al. do not render obvious claims 15, 17, 19, 21 and 27 for the following reasons.

As provided above, Groten et al. and Fujiwara et al. do not disclose or suggest or suggest water-jet prebonded fibers.

The addition of Hassenboehler, Jr. et al. does not cure the defects of Groten et al. and Fujiwara et al. Hassenboehler, Jr. et al. are merely used in the Office Action to allegedly subject a web to a secondary drawing and tempering. Hassenboehler, Jr. et al. do not disclose or suggest any water-jet prebonded fibers. As a result, the combination of references do not disclose or suggest the features of claim 14.

Claims 15, 17, 19, 21 and 27 depend from claim 14 and include all of the features of claim 14. Claims 15, 17, 19, 21 and 27 are therefore patentable for at least the reasons presented in relation to claim 14.

IV. Rejection of Claim 32 Under 35 U.S.C. § 103(a)

Claim 32 was rejected under 35 U.S.C. § 103(a) as unpatentable over Groten et al. and Fujiwara et al. in view of United States Patent 5,866,675 ("Ahmed et al."). Applicants respectfully submit that the combination of Groten et al., Fujiwara et al. and Ahmed et al. do not render obvious claim 32 for the following reasons.

As provided above, Groten et al. and Fujiwara et al. do not disclose or suggest or suggest water-jet prebonded fibers.

The addition of Ahmed et al. does not cure the defects of Groten et al. and Fujiwara et al. Ahmed et al. are merely used in the Office Action to allegedly create a nonwoven web using an additive. Ahmed et al. do not disclose or suggest any water-jet prebonded fibers. As a result, the combination of references do not disclose or suggest the features of claim 14.

Claim 32 depends from claim 14 and include all of the features of claim 14. Claim 32 is therefore patentable for at least the reasons presented in relation to claim 14.

V. Conclusion

It is therefore respectfully submitted that all pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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